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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/694,327

10/27/2003

Masaaki Matsutani

NAKAKURA.023AUS

3846

7590

02/27/2007

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EXAMINER

TYSON, MELANIE RUANO

ART UNIT

PAPER NUMBER

3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/694,327

Applicant(s)

MATSUTANI ET AL.

Examiner

Melanie Tyson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 4 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 1, 5, and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to applicant's amendment received on 14 December 2006. All corrections made are accepted.

#### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1 and 4-8 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim Objections***

3. Claims 1, 5, and 8 are objected to because of the following informalities: typographical errors. For example, in claims 1 and 5 the term "an" may be inserted between the phrases "from one side of either" and "inside or outside" and in claim 8, the term "a" may be inserted between the terms "wherein" and "distance." Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Scholl (Patent No. 3,893,238). Scholl discloses a knife (Figures 1-3) comprising a rod-shaped grip

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(17), a cutter holder (the assembly 16, 18, 20, 21, and 80) being detachably attached to a tip portion of the rod-shaped grip (See Figure 2) and having a knife main body (19), a first bent portion formed on the rod-shaped grip (adjacent element 44) and a second bent portion formed on the cutter holder (between portions 26 and 27). Figure 2 shows the tip portion (40) of the rod-shaped grip (17) has a plate-like shape (since it formed of a thin piece of material of uniform thickness), is provided with a long hole (hole 42 penetrates down through the center portion to hole 43 on the other side of the tip portion, thus provides a long hole), and is provided with a slit at the tip (the holes 42 and 43 run through tip 40, thus providing a slit at the tip portion). Figure 2 further shows the cutter holder (the assembly 16, 18, 20, 21, and 80) has a first engagement portion (portion of tail 27 and portion of main body 26) that engages with the long hole, and a second engagement portion (portion of body 26) that is inserted in the slit.

The introductory statement of intended use has been carefully considered, but deemed not to impose any structural limitations on the claims to make them patentably distinguishable over Scholl's device, which is capable of being used as claimed if one desires to do so.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholl. Scholl discloses a device as described above, however, does not specifically disclose what the angle is between the grip and the knife main body. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the angle between the grip and the knife main body fall between 10 degrees and 60 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Furthermore, Scholl does not specifically disclose what the distance is from the first bent portion to the knife main body. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a distance of 3 cm between the first bent portion and the knife main body, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scholl in view of Frantzen (Patent No. 5,769,866). Scholl discloses a device as described above,

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including a linearly formed cutter (69) on the knife main body (19); however, Scholl does not disclose the cutter is oriented upwardly. Frantzen discloses an incision device (Figures 8-10 and 12). Frantzen teaches the cutter (174) of the knife main body (170) is oriented upwardly (see Figures 8-10 and 12 for illustration). It would have been obvious to one of ordinary skill in the art at the time the invention was made to orient the cutter of Scholl upwardly as taught by Frantzen in order to provide a forward cutting incision device (column 7, lines 52-53), thus providing a device that can form an incision in a lumen in an accurate and reliable fashion in a surgical environment where little maneuvering room is provided for the incision device (column 2, lines 56-63) since the view of the line of incision is not being blocked by the users hand when performing a forward incision.

***Allowable Subject Matter***

10. Claim 1 is allowable. The following is a statement of reasons for the indication of allowable subject matter: The inclusion of the limitation the cutter holder engages the tip portion of either inside or outside of the tip portion and projects from an opposite side of the tip portion, and an angle between the rod-shaped grip and the knife main body is changeable depending on whether the cutter holder is engaged with the tip portion from the inside or the outside of the tip portion. This limitation is included in all the claims and is not found in the prior art references.

11. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

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claim and any intervening claims. The reasons for the indication of allowable subject matter are the same as the reasons given for claim 1 (see above).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571) 272-9062. The examiner can normally be reached on Monday through Friday 9:00 a.m. - 5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson *MT*  
February 15, 2007

  
**ANH TUAN T. NGUYEN**  
**SUPERVISORY PATENT EXAMINER**  
*2/15/07*